

REMARKS

This amendment is in response to the final Official Action dated February 12, 2007. Claims 1, 3, 4, 7-13, and 22-33 are currently pending in connection with the present application. Claims 1, 24, and 31 are independent claims. In this amendment, claims 1, 22, 24, 25, 31, and 32 have been amended. Reconsideration and allowance is requested in view of the claim amendments and the following remarks.

Entry of Amendment Requested

Applicant submits that, at the least, the amendment should be entered since it reduces the number of substantive and/or formal issues necessary to place the application in better form for appeal. Additionally, claim 1 has been amended to include subject matter previously recited as part of dependent claim 22, claim 24 has been amended to include subject matter previously recited as part of dependent claim 25, and claim 31 has been amended to include subject matter previously recited as part of dependent claim 32. Accordingly, Applicant respectfully submits that these amendments cannot be fairly and justifiably concluded as resulting in the raising of new issues for the purposes of further consideration by the Examiner.

35 U.S.C. § 103 Rejections

Claims 1, 3, 4, 7-10, 12, and 22-33 have been rejected under 35 U.S.C. § 103(a) as obvious over **Niikawa** (U.S. Patent No. 6,757,479) in view of **Ito** et al. (U.S. Patent No. 6,329,787). Applicant respectfully traverses this rejection.

Amended claim 1 now recites: *[a] method comprising:*

storing content on a portable memory device, said content including an image captured using a recorder/playback device...

detaching the portable memory device from the recorder/playback device;

displaying the image on the portable memory device while the portable memory device is detached from the recorder/playback device, and displaying functional controls for the

recorder/playback device while the portable memory device is connected to the recorder/playback device.

These claimed features include a portable memory device that can display stored images while the memory device is detached, and display information for controlling the recorder/playback device, while the memory device is attached. These claimed features illustrate the relationship between the memory device and recorder/playback device.

These claimed features are also absent from the relied upon references.

Niikawa discloses an image display device that accommodates browsing through image files. Although figure 2 mentions a portable memory device 8, this is a conventional portable memory device (e.g., a flash drive, floppy disk, etc.) that does not include a display. Additionally, portable memory device 8 is separate from the display device 1. Thus, Niikawa merely appears to disclose a conventional portable memory device 8, which may be inserted into a reading apparatus, such as the image display device 1.

With respect to claim 1, Niikawa clearly does not disclose or suggest, “*displaying the image on the portable memory device while the portable memory device is detached from the recorder/playback device; and displaying functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device.*” Instead, Niikawa appears to merely disclose a conventional portable memory card that does not have a display functionality. Thus, it cannot be fairly said that Niikawa discloses or in any way suggests the claimed subject matter.

The Examiner admits that Niikawa does not teach “*displaying the image on the portable memory device while the portable memory device is detached from the recorder/playback device*” as recited in independent claim 1. Applicant agrees.

Ito does not remedy the deficiencies of Niikawa. Ito discloses a portable digital media viewing device for viewing pictures, images, sounds, video, etc. (column 5, lines 25-30). Figure 1

illustrates portable device 14 having display 12 and controls 32. A battery-charging device 24 charges portable device 14. Charging device 24 connects to a power source 50 and a data source 44 (or 147, in figure 5). Figure 3 illustrates the charging process for portable device 14. Prior to mounting portable device 14 onto charging device 24, a user selects the content that charging device 24 will provide portable device 14 (step 2; column 6, lines 51-56). This selection may be made via controls mounted on charging device 24 or by pre-setting the desired media information in portable device 14 (column 6, lines 51-56). Thereafter, after mounting portable device 14 onto charging device 24, charging device 24 serves the dual purpose of charging (step S4) and providing digital content for transfer and storage on portable device 14 (steps S8-S9). Ito does not provide or suggest any device for controlling the recording or capture of digital content, nor does Ito suggest displaying control information while the portable viewer is connected to the charger.

With respect to claim 1, as with Niikawa, Ito also does not disclose or suggest both *“displaying the image on the portable memory device while the portable memory device is detached from the recorder/playback device,”* and *“displaying functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device.”* Instead, Ito merely discloses selecting content to load from a passive data source. Ito offers no disclosure of having the portable device 14 display functional controls or related information for controlling a recorder/playback device for recording or capturing images.

Applicant submits that, even if Niikawa and Ito were combinable (which is not admitted), the combination would fail to teach or suggest *“displaying the image on the portable memory device while the portable memory device is detached from the recorder/playback device; and displaying functional controls for the recorder/playback device while the portable memory device is connected to the recorder/playback device.”* The great disparities between the devices disclosed in Niikawa (i.e., a multi-component image capture and editing workstation) and Ito (i.e., a portable digital media device) would not prompt one of ordinary skill, and indeed provide no evidence whatsoever to support a conclusion that it would have been obvious to the ordinarily skilled artisan, to create a device wherein the small memory device displays control information for controlling the multi-component image capture and editing system. Moreover, **neither Niikawa nor Ito teach a**

portable memory device that does anything more than store or display content. Although Ito mentions pre-setting the desired type of content to load into a portable media device, Ito offers no disclosure of, and offers no evidence or reason to support a conclusion that the artisan would modify Niikawa to create a portable memory device that functions as part of a user interface for another device. Instead, a combination of Niikawa and Ito would only provide a memory device, attachable to an image editing system, capable of displaying images stored thereon.

Since even a combination of the relied upon references would still fail to yield the claimed invention, Applicant submits that a *prima facie* case of obviousness for claim 1 has not been presented. Applicant also notes that the offered combination appears to be a (failed) attempt to reconstruct the claimed invention in hindsight, as there is no basis to combine Niikawa's image editing system with Ito's portable television and charger. For similar reasons, claims 24 and 31 are also neither disclosed nor suggested by Niikawa and Ito, alone or in combination.

Dependent claims 3, 4, 7-10, 12, 22, 23, 25-30, 32, and 33 incorporate the features recited in independent claims 1, 24, or 31 and thus are not suggested by the combination of Niikawa and Ito. Moreover, they separately recite features that are patentably distinct from the reference.

In particular, Applicant notes that claims 22, 23, 25-27, 32, and 33 are clearly neither disclosed nor suggested by Niikawa.

Claim 22 recites "*wherein said functional controls include soft keys that are particular to the recorder/playback device.*" There is no mention of any kind regarding soft keys with either Niikawa or Ito. For similar reasons, claims 25 and 32 are not disclosed.

Claim 23 recites "*wherein the portable memory device is configured to include an attachment area, said attachment area including a magnet for attaching the portable memory device to a metallic object, such that the portable memory device displays the image while attached to the metallic object*". The Examiner rejected claim 23 by taking official notice that using magnets to attach metallic devices is known. Applicant objects generally to the examiner's taking of official notice, and in particular notes that the examiner fails to identify that using magnets to attach

“portable memory devices” is “known in the art” by anything beyond mere conjecture and conclusory statements.

“Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).”

MPEP § 2144.03 (A)

The Examiner has failed to provide any “known” examples where magnets are used to connect memory devices. Applicant submits that the use of magnets to attach a memory device is not obvious due to the need to prevent damage to the memory device from the magnetic device. For similar reasons, claims 26 and 33 are not disclosed.

Claim 27 recites “*wherein the interface means connects to and detaches from the recorder/playback device via a wireless connection.*” Neither Niikawa nor Ito disclose any wireless connection capable of supporting an interface to a recorder/playback device. Furthermore, the Ito device employs a cradle, which fails to meet the definition of a wireless connection as understood by one of ordinary skill.

Claims 11 and 13 have been rejected under 35 U.S.C. § 103 as being unpatentable over Niikawa in view of Ito in view of Ishino et al. (U.S. Patent No. 7,016,595).

As previously described neither Niikawa nor Ito disclose or suggest at least the features *a display means ... configured to display functional controls for the recorder/playback device while*

the portable memory device is connected to the recorder/playback device as recited in claim 1.
Dependent claims 11 and 13 depend on independent claim 1 and therefore include the features of independent claim 1.

Even assuming, arguendo, that Niikawa, Ito, and Ishino were combinable, Applicant submits that Ishino fails to cure the deficiencies of Niikawa and Ito with respect to at least the previously identified features of claim 1.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 103(a).

In view of the above amendment, applicant believes this application is in condition for allowance. The Examiner is invited to contact the undersigned representative, Christopher M. Tobin, at the provided number to expedite or further resolution of any issues that remain regarding the application.

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Respectfully submitted,

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